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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,806	08/13/2002	Josep Torrents I Comas	P/2789-58	3091

7590 04/21/2005

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New York, NY 10036-8403

EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/089,806

Applicant(s)

TORRENTS I COMAS, JOSEP

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/9/04 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as anticipated by ES 2,101,612, hereinafter ES '612, or, in the alternative, under 35 U.S.C. 103(a) as obvious over ES 2,101,612.

ES '612 discloses the same invention as claimed including: a base (the support for ceramic 3); longitudinal guides (unlabeled but shown in Figure 1); a support movably

mounted on the guides (1); a cutting wheel handle holder (33, see Figures 1 and 2, wherein the tool 2 is attached to shaft 30 which is attached to holder portion 33 that is shown as pivotal to the support); a cutting wheel handle (30) mounted in the handle holder; a cutting wheel (2) mounted on the handle; an actuating lever (6) mounted in a thread hole in the handle holder (see Figure 2) so as to immobilize the handle so that the handle applies pressure on a ceramic piece (3) to be cut by the cutting wheel. The cutting wheel handle (30) having an outer periphery with at least three longitudinally extending rebates (see 31/32 in Figure 5) extending over substantially an entire length of the cutting wheel handle as shown in Figure 1 (the portion inserted into the cutting wheel handle holder) and at least one longitudinally extending planar surface (34) for engaging the actuating lever (see page 2, lines 1-17 and page 3, lines 1-16).

In the alternative, even if it is argued that the rebates as shown in Figure 1 is not substantially extending over the entire length of the handle, it would have been an obvious matter of design choice at the time of the invention was made to a person of ordinary skill in the art to extend the rebates over substantially the entire length of the cutting wheel handle instead of the portion as shown in Figure 1 for the purpose of allowing height adjustment of the cutting wheel relative to the workpiece support because applicant has not disclosed that the rebates extending for substantially the entire length of the handle provides any advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either amount of rebate length taught by ES '612 or the claimed length because both rebate lengths perform the

same function of mounting the cutting wheel handle to the cutting wheel handle holder with reduced vibration during scoring a ceramic workpiece. Therefore, it would have been obvious matter of design choice to modify ES '612 to obtain the invention specified in claim 3.

It should be noted that the phrase "the rebates having a geometry so as to reduce a frequency of vibration during scoring of the ceramic piece by the cutting-wheel" is merely functional/intended use not defining any specific structure. ES '612 includes all of the same structure as claimed and is fully capable of the above-intended use.

As to claim 4, the cutting wheel handle holder of ES '612 forms a housing having a transverse section (see Figure 2) that corresponds to a transverse section of the cutting wheel handle, wherein the actuating lever, cutting wheel handle and cutting wheel handle holder form a hyperstatic fixing (the actuating lever 6 screws into the shaft handle 30 of the cutting wheel to force the cutting wheel handle/shaft against the cutting wheel handle holder, see Figure 1, 2, 3).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 3 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Applicant contends that ES '612 lacks the rebates extending for substantially the entire length of the handle; however, this argument is address in the new rejection above. It should further be noted that the instant application does not provide any criticality to the new claimed limitation of rebates extending substantially the entire

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length of the handle. Nor is there any suggestion in the instant application that the increased rebate length facilitates in solving the vibration problems of none rebated handles or short rebated handles. Similarly, there are no expected results by extending the length of the rebate on the handle.

6. For the reasons above, the grounds of rejection are deemed proper.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

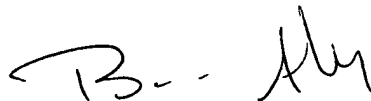
The prior art references cited but not relied upon were cited to shown similar devices in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
April 18, 2005